

Appl. No. : **10/039,291**
Filed : **January 3, 2002**

REMARKS

This Amendment is responsive to the Office Action mailed October 20, 2004. Applicant has canceled Claims 1 – 40, and 50 without prejudice. Applicant expressly reserves the right to pursue the canceled claims in one or more continuing applications. Applicant has amended Claims 41 – 49, and 51 – 54. Applicant has added new Claims 55 – 63. Applicant has filed an RCE herewith.

Allowable Subject Matter

The Examiner has indicated that Claims 41-43 would be allowable if: (1) rewritten to comply with 35 U.S.C. § 112, first and second paragraphs and (2) rewritten to incorporate the limitations of the base claim and any intervening claims. Applicant has amended Claims 41-43 to comply with the Examiner's requests.

The Examiner noted:

The prior art does not fairly suggest, teach or disclose using a fluoride mixture having a fluoride concentration in the range of about 0.002 ppm fluoride to about 45 ppm fluoride....

Furthermore, Applicant has demonstrated that when such extremely low amounts of fluoride are used in the instantly claimed systems, unexpected synergistic results are obtained. ...This in no way could have been predicted from the art of record.

Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected Claims 37-40 and 44-54 under 35 U.S.C. § 103(a), Applicant has canceled Claim 37-40, and 50. Applicant has amended Claims 44-49, and 51-54 to depend from an allowable base claim, namely Claim 41 (which stands unrejected over the art). Accordingly, Applicant respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 103(a).

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Rejection Under 35 U.S.C. § 112, Second Paragraph (Indefiniteness)

The Examiner rejected Claims 37-54 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has canceled Claim 37-40, and 50.

The Examiner objected to the term “viscous” because, according to the Examiner, “the specification appears in fact to disclose only those fluoride mixtures which are sufficiently viscous to be self-supporting.” The Examiner expressed concern that the term “viscous” did not exclude non-self supporting mixtures such as liquids. Accordingly, Applicant has amended Claims 41-43 to delete the term “viscous” for clarity. Claims 41-43 recite “*wherein said fluoride mixture has a consistency of a gel or a paste.*”

The Examiner objected to the term “substantially” because, according to the Examiner, this term is indefinite. Accordingly, Applicant has amended independent Claims 41-43 to delete the term “substantially.” Applicant has replaced the phrase “to substantially prevent” with “to reduce or minimize.”

Accordingly, in view of the above amendments, Applicant respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 112, First Paragraph (Enablement)

The Examiner rejected Claims 37-54 under 35 U.S.C. § 112, first paragraph, because, according to the Examiner, the specification has not enabled the term “prevent.” Applicant has canceled Claim 37-40. Applicant has amended Claims 41-43 to delete the term “prevent.” Applicant has replaced the phrase “to substantially prevent” with “to reduce or minimize.”

Accordingly, in view of the above amendments, Applicant respectfully request that the Examiner withdraw the enablement rejection under 35 U.S.C. § 112, first paragraph.

Rejection Under 35 U.S.C. § 112, First Paragraph (New Matter)

The Examiner rejected Claims 37-43 and 45-54 because the term “viscous” is not expressly recited in the specification and, according to the Examiner, constitutes new matter. Applicant has canceled Claim 37-40. Applicant has amended independent Claims 41-43 to delete the term “viscous.” Accordingly, Applicant respectfully request that the Examiner withdraw the enablement rejection under 35 U.S.C. § 112, first paragraph.

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Rejection Under 37 C.F.R. § 1.75

The Examiner objected to Claim 50 as being a substantial duplicate of Claim 51. Applicant has canceled Claim 50. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection under 37 C.F.R. § 1.75.

New Claims

Applicant has added New Claims 55 – 63. New Claims 55-62 are all dependent from an allowable base claim, namely Claim 41. No new matter has been added by New Claims 55 – 63 and Applicant respectfully submits that New Claims 55 – 63 are in condition for allowance.

In view of the above remarks, Applicant respectfully submits that all of the pending claims are patentable over the cited art, and that the present application is in condition for allowance.

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CONCLUSION

In view of the foregoing remarks, Applicant respectfully asserts that the present application is fully in condition for allowance. If any issues remain that may be addressed by a phone conversation, the Examiner is invited to contact the undersigned at the phone number indicated below.

Appropriate fees have been submitted herewith. No further fees are believed to be due. However, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 17, 2005

By:



Salima A. Merani, J.D., Ph.D.

Attorney at Law

Recognized under 37 CFR § 11.9(b)

For Attorney of Record,

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and all other registrants of the law firm of

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